

REMARKS

This Amendment is filed in response to the Office Action dated February 26, 2004. Applicants initially note with appreciation the Examiner's continued thorough examination of the application as evidenced by the Office Action. With regard to the Amendment, Applicants have amended Claims 1, 3, and 10 so as to clarify the claims. Applicants, however, did not amend the claims based on the rejections outlined in the Office Action, as Applicants believe that the claims as presently presented are patentable over the cited references. Applicants therefore request reconsideration of the claims in light of the following remarks.

I. Claims 1, 10, 18, 21, and 24 Are Definite

In paragraphs 3 and 4, the Office Action rejects Claims 1, 10, 18, 21, and 24 as indefinite under § 112, second paragraph. The Office Action alleges that the term "customer request" is indefinite as it is not clear what the request is. Applicants disagree with this rejection. Patent law concerning indefiniteness issues does not require that Applicants be any more specific than "a customer request." The term "a" introduces the term, giving it antecedent basis. Further, the term "customer request" could refer to any request made by a customer no matter what the request relates to. Indefiniteness should not be confused with breadth, which is permissible. Applicants respectfully submit that the amended claims are definite.

II. Claims 1, 3, and 21 Are Directed to Statutory Subject Matter

In paragraphs 5 and 6, the Office Action alleges that Claims 1, 3, and 21 are directed to non-statutory subject matter. Specifically, the Office Action alleges that although these claims do produce useful, concrete and tangible results, they do not apply, involve, use, or advance the technological arts. The Office Action essentially argues that the steps of these claims can be performed in person or by use of pencil and paper without use of a computer. The Office Action argues that recitation that the steps are performed by a processor in the claims is not sufficient. Applicants respectfully disagree with this rejection. Applicants respectfully submit that the Office Action's reasons for rejections are not in line with current US patent laws as defined by

the Federal Circuit in *State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368 (Fed. Cir. 1998). In fact, Applicants submit that the Office Action is applying an outdated test that has been replaced by the decision in *State Street*. A copy of the *State Street* opinion is enclosed.

In *State Street*, the Federal Circuit stated that, for the most part, any invention that is one of a process, machine, manufacture, or composition of matter is statutory subject matter. The Court, however, noted three exceptions to this rule, namely laws of nature, natural phenomena, and abstract ideas. The Court touched on the latter exception of abstract ideas. *State Street*, 149 F.3d at 1373. In this regard, the Court stated that the test is that the invention must 1) fall into one of the listed categories: process, machine, manufacture, or composition of matter and 2) produce a "useful, concrete, and tangible result." In this regard, the claimed invention is a method for creating a marketing initiative. The terms method and process are considered synonymous in patent law. Further, as already admitted by the Office Action, the claimed invention produces a useful, concrete, and tangible result. This is all that is needed to qualify as statutory subject matter as outlined by the Federal Circuit. See *State Street*, 149 F.3d, at 1375.

Applicants note here that the Court nowhere mentions determining whether the invention "applies, involves, uses, or advances the technological arts" as the Office Action is requiring. In fact this phrase is no where present in the Opinion.

Applicants submit that the *State Street* opinion provides a good example of why the present invention should be considered statutory subject matter. Specifically, in that case, the Federal Circuit found that a machine that determined a daily allocation of assets for two or more Spokes that are invested in the same Hub. The system determined the percentage share that each Spoke maintained in the Hub, while taking into consideration daily changes both in the value of the Hub's investment securities and in the concomitant amount of each Spoke's assets. The functions performed by the machine in *State Street* could have clearly been done with pen and paper. However, the Federal Circuit found the machine to contain statutory subject matter. As such, the Office Action's finding that the present invention is not statutory subject matter because the steps listed can be performed with pen and paper is completely contrary to the findings of the Federal Circuit to an analogous invention in the *State Street* case. Applicants

therefore submit that Claims 1, 3, and 21 do recite statutory subject matter as outlined by the Federal Circuit in *State Street*.

III. The Claims Are Patentable

In paragraphs 7 and 8, the Office Action rejects all of the claims under 35 U.S.C. § 102(e) as anticipated by US Patent No. 6,286,005 to Cannon. The Office Action essentially states that all aspects of the claims are taught by this reference. Applicants respectfully disagree with this finding.

Applicants first state that in reviewing of the '005 Cannon patent, Applicants note several aspects of the various Claims 1-7, 10-15, 18, and 21-46 that are not taught or suggested by the reference. However, for purposes of brevity, Applicants have chosen to only touch on a few patentable aspects of the independent claims.

In citing the '005 Cannon patent, the Office Action has overlooked a fundamental difference between the present invention and the system described in the '005 Cannon patent. Specifically, the premise of the present invention is to compare a new marketing initiative with past marketing initiatives to see how the new initiative will succeed. The present invention first determines which prior initiatives closely match the new initiative. The system then evaluates the success of the prior initiatives to provide the user with information about the potential success of the new initiative. The database in the claimed invention does not include mere raw statistical data concerning customer demographics. Instead, the database includes data relating to the success of past marketing initiatives. This data relating to past initiatives is compared with the new marketing initiative to give the user an idea of the possible success of the new initiative.

This aspect of the present invention is reflected in the claims. Specifically, Claim 1 recites:

determining a likelihood that the new initiative will be effective prior to use of the new initiative using stored statistics reflecting hit rates based on characteristics of other past initiatives, where the hit rates indicate the number of times an initiative was selected as being relevant to a customer request for availability or sales information

The claims clearly recite comparing the new marketing initiative with the statistics relating to success of past marketing initiatives.

The '005 Cannon patent nowhere discloses this aspect of the present invention. Instead, the '005 Cannon patent discloses only storing raw data relating to TV ratings and demographics. In the '005 Cannon patent, a new initiative is compared to this raw data, not to statistics of prior marketing initiatives. As such, in the '005 Cannon, no indication of how an initiative will do based on passed marketing initiatives is provided. The user can only compare the new marketing initiative to raw TV viewing and demographic data. For the '005 Cannon patent to even come close to the claimed invention, it would have to teach or suggest storing of statistics for previous advertisements and comparing new proposed advertisement to the previous advertisements to determine the possible success of the new proposed advertisement. The '005 Cannon patent does not teach or suggest such a system. It only discloses storing of statistical data relating to the demographic viewing audience of a particular network, day, and time slot. It nowhere teaches or suggests how previous advertisements have fared in those timeslots or comparison of newly proposed advertisements with the success of previous advertisements. A user of the '005 Cannon system is left to self-determine whether their newly proposed advertisement will do well with the demographics of a particular day and time slot for a particular network. The claimed invention remedies this very problem by allowing the user to assess the new proposed initiative in light of how previous similar initiatives have done. The user thus does not have to look at raw demographic data. In short, the claimed invention is a novel and non-obvious improvement over the system of the '005 Cannon patent, as it alleviates the need to review raw demographic data and make presumptions about the success of a new initiative. Instead, the user can merely compare the new initiative to the success rate data associated with previous like initiatives. For the above reasons, Applicants respectfully submit that all of the claims are patentable over the cited references.

CONCLUSION

In view of the amended claims and the remarks presented above, it is respectfully submitted that all of the present claims of the application are in condition for immediate

allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

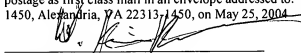


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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 25, 2004.


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